UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,821	06/20/2001	Roderic C. E. Butler	22266-05104	6324

7590 09/13/2005	EXAMINER
Edward J Radlo	THAI, CANG G
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Palo Alto, CA 94306	3629

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	**Applicant(s)**
Office Action Summary	09/868,821	BUTLER ET AL.
	Examiner	**Art Unit**
	Cang G. Thai	3629

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>20 June 2001</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All   b)☐ Some *   c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

Priority

The later-filed application must be an application for a patent for an invention

which is also disclosed in the prior application (the parent or original non-provisional

application or provisional application); the disclosure of the invention in the parent

application and in the later-filed application must be sufficient to comply with the

requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v.*

Performance Contracting, Inc., 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

2.   Claims 1-39 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent No. 6,366,925 (MELTZER ET AL).

As for claim 1, MELTZER discloses a system by which a provider provides

services to clients via computer, said system comprising:

first computing means by which a potential client obtains access to register with

the system {See Fig. 2D, Element 134};

coupled to the first computing means, second computing means partitioned into a plurality of private areas, wherein each private area is dedicated to a single client, other clients not being granted access to said private area {See Fig. 2D, Element 136}; and

coupled to the first computing means and to the second computing means, third computing means to which the provider has access but the clients do not have access {See Fig. 2D, Element 142}.

As for claim 2, MELTZER discloses the system of claim 1 wherein the services are legal services {Column 2, Lines 14-15, wherein this reads over "to provide a legal services network that automates the receipt of information form a client"}.

As for claim 3, MELTZER discloses the system of claim 1 wherein the second computing means and the third computing means are part of the same computer {Column 2, Lines 21-22, wherein this reads over "legal services via a computer interface without directly contacting an attorney"}.

As for claim 4, MELTZER discloses the system of claim 1 wherein the client accesses the first computing means in an online manner {See Fig. 2A, Element 100}.

As for claim 5, MELTZER discloses the system of claim 4 wherein the client accesses the first computing means via an open network {Column 2, Lines 27-28, wherein this reads over "a network based system for the provision of legal services via the worldwide web"}.

As for claim 6, MELTZER discloses the system of claim 1 wherein the client accesses the first computing means in an offline manner {Column 11, Lines 10-11,

wherein this reads over "the interface or page 136 also includes hyperlinks to the restricted access "frequently asked questions" page 138"}.

As for claim 7, MELTZER discloses the system claim 1 wherein the client is remote from at least one of said computing means {Column 11, Lines 15-16, wherein this reads over "linking to the inquiry posting page 140 which will present an interface"}.

As for claim 8, MELTZER discloses the system of claim 1 wherein the provision of services is the formation and organization of a corporation {Column 11, Lines 17, wherein this reads over "the "E-Consultation" page"}.

As for claim 9, MELTZER discloses the system claim 8 wherein the incorporation is formed according to the laws of Bermuda {See Fig. 2A, Element 118}.

As for claim 10, MELTZER discloses the system of claim 1 wherein the first computing means performs at least one of the following functions:

gives answers to frequently asked questions {See Fig. 2E, Element 113};

allows the client to register with the system {See Fig. 2C, Element 132};

allows the client to log into the system {See Fig. 2D, Element 134};

gives the client a demonstration of the system {See Fig. 2C, Element 126};

allows the client to learn more about the system {See Fig. 2D, Element 140};

allows the client to download a registration questionnaire {See Fig. 2C, Element 140};

allows the client to send an e-mail to the provider {See Fig. 2C, Element 124}.

As for claim 11, MELTZER discloses the system of claim 1 wherein the second computing means performs at least one of the following functions:

allows the client to fill out a registration questionnaire at least in part {See Fig.

4A, Element A-1 Questionnaire};

allows the client to determine the status of the work being performed on the

client's behalf by the provider {See Fig. 4B, Element "Current Non-Immigrant Status"};

allows the client to change the client's user profile {See Fig. 4D, Element

"Reset"}.

As for claim 12, MELTZER discloses the system of claim 1 wherein the second

computing means allows the client to fill out a questionnaire eliciting information

regarding the nature of the services appropriate for the client {See Fig. 7C, Element

"Question Responses"}.

As for claim 13, MELTZER discloses the apparatus of claim 12 wherein the

questionnaire contains means to permit the client to pay for the services performed on

the client's behalf {See Fig. 7A, Element "Credit Card Response"}.

As for claim 14, MELTZER discloses the system of claim 13 wherein a third

party, other than the client and the provider, facilitates the payment of the services {See

Fig. 7A, Element "Administrative Page"}.

As for claim 15, MELTZER discloses the system of claim 12 wherein the client's

inputting information into the questionnaire provokes an e-mail message to the provider

alerting the provider that an entity wishes to have services performed on the entity's

behalf "See Fig. 7A, Element "Administrative Page"}.

As for claim 16, MELTZER discloses the system of claim 12 wherein the services

are the formation and organization of a corporation, and the questionnaire elicits

information concerning at least one of the following:

a corporate name reservation {See Fig. 7B, Element "Account No."};

an intended business for the corporation {See Fig. 7B, Element "Family Name"};

authorized share capital {See Fig. 7B, Element "Foreign Address"};

identification of shareholders {See Fig. 7B, Element "First Name"};

identification of directors and officers {See Fig. 7B, Element "Current

Nonimmigrant Status"}; and

an accounting reference date {See Fig. 7B, Element "INS receipt # of

change/extension of family member"}.

As for claim 17, MELTZER discloses the system of claim 12 further comprising

means for the client to accept the law of a certain jurisdiction before the questionnaire is

forwarded to the provider {See Fig. 4A, Element "A-1 Questionnaire"}.

As for claim 18, MELTZER discloses the system of claim 1 wherein the provision

of services is the provision of legal services, and the legal services can be performed

according the laws several jurisdictions {See Fig. 4A, Element "A-1 Questionnaire"}.

As for claim 19, MELTZER discloses the system of claim 1 wherein the provider

uses the third computing means to gather and store information relevant to the provision

of the services {See Fig. 2C, Element 124}.

As for claim 20, MELTZER discloses a method for providing services to clients

via computer, said method comprising:

permitting a potential client to have access to a first computing means to enable

said potential client to register with a provider of the services {See Fig. 2C, Element

126};

providing a second computing means, coupled to the first computing means, to

facilitate a client's access to the services, wherein the second computing means is

partitioned into a plurality of private areas, each private area dedicated to a single client,

other clients not being granted access to said private area {See Fig. 2C, Element 132};

and

allocating a third computing means, coupled to the first computing means and to

the second computing means, to the provider, wherein the provider has access to the

third computing means but the clients do not {See Fig. 2C, Element 124}.

As for claim 21, MELTZER discloses the method of claim 20 wherein the

services are legal services {See Fig. 2C, Element 140}.

As for claim 22, MELTZER discloses the method claim 20 wherein the second

computing means and the third computing means are part of the same computer {See

Fig. 2D, Element 142}.

As for claim 23, MELTZER discloses the method of claim 20 wherein the client

accesses the first computing means in an on-line manner {See Fig. 2D, Element 134}.

As for claim 24, MELTZER discloses the method of claim 23 wherein the client

accesses the first computing means via an open network {See Fig. 2D, Element 136}.

As for claim 25, MELTZER discloses the method of claim 20 wherein the client

accesses the first computing means in an off-line manner {See Fig. 2C, Element 124}.

As for claim 26, MELTZER discloses the method of claim 20 wherein the client is remote from at least one of said computing means {See Fig. 2C, Element 126}.

As for claim 27, MELTZER discloses the method of claim 20 wherein the provision of services is the formation and organization of a corporation {See Fig. 2C, Element 129}.

As for claim 28, MELTZER discloses the method of claim 27 wherein the incorporation is formed according to the laws of Bermuda {See Fig. 2C, Element 129}.

As for claim 29, MELTZER discloses the method of claim 20 wherein the first computing means performs at least one of the following functions:

gives answers to frequently asked questions {See Fig. 2C, Element 138};

allows the client to register with the provider {See Fig. 2A, Element 116};

allows the client to log into the second computing means {See Fig. 2A, Element 100};

gives the client a demonstration of the computerized provision of services {See Fig. 2A, Element 104};

allows the client to learn more about the computerized provision of services {See Fig. 2A, Element 118};

allows the client to download a registration questionnaire {See Fig. 2B, Element 120};

allows the client to send an e-mail to the provider {See Fig. 2A, Element 116}.

As for claim 30, MELTZER discloses the method of claim 20 wherein the second computing means performs at least one of the following functions:

allows the client to fill out a registration questionnaire at least in part {See Fig.

2C, Element 140};

allows the client to determine the status of the work being performed on the

client's behalf by the provider {See Fig. 2C, Element 132};

allows the client to change the client's user profile {See Fig. 2C, Element 124}.

As for claim 31, MELTZER discloses the method of claim 20 wherein the second

computing means allows the client to fill out a questionnaire eliciting information

regarding the nature of the services appropriate for the client {See Fig. 2C, Element

129}.

As for claim 32, MELTZER discloses the method of claim 31 wherein the

questionnaire contains means to permit the client to pay for the services performed on

the client's behalf {See Fig. 3A, Element "Questionnaire"}.

As for claim 33, MELTZER discloses the method of claim 32 wherein a third

party, other than the client and the provider, facilitates the payment of the services {See

Fig. 3B, Element "E-Consultation"}.

As for claim 34, MELTZER discloses the method of claim 31 wherein the client's

inputting information into the questionnaire provokes an e-mail message to the provider

alerting the provider that an entity wishes to have services performed on the entity's

behalf {See Fig. 4D, Element "Email Address"}.

As for claim 35, MELTZER discloses the method of claim 31 wherein the

services are the formation and organization of a corporation, and the questionnaire

elicits information concerning at least one of the following:

a corporate name reservation {See Fig. 7B, Element "Account No."};

an intended business for the corporation {See Fig. 7B, Element "Family Name"};

authorized share capital {See Fig. 7B, Element "Foreign Address"};

identification of shareholders {See Fig. 7B, Element "First Name"};

identification of directors and officers {See Fig. 7B, Element "Current

Nonimmigrant Status"}; and

an accounting reference date {See Fig. 7B, Element "INS receipt # of

change/extension of family members"}.

As for claim 36, MELTZER discloses the method of claim 31 further comprising

means for the client to accept the law of a certain jurisdiction before the questionnaire is

forwarded to the provider {See Fig. 4A, Element "A-1 Questionnaire"}.

As for claim 37, MELTZER discloses the method of claim 20 wherein the

provision of services is the provision of legal services, and the legal services can be

performed according to the laws of several jurisdictions {See Fig. 4A, Element "A-1

Questionnaire"}.

As for claim 38, MELTZER discloses the method of claim 20 wherein the provider

uses the third computing means to gather and store information relevant to the provision

of the services {See Fig. 2C, Element 124}.

As for claim 39, MELTZER discloses a computer readable medium containing

computer executable instructions for enabling a provider to provide services to clients,

said instructions comprising:

allowing a potential client to obtain access to a first computing means to register

with the provider {See Fig. 2C, Element 126}; and

allowing a client to obtain access to a second computing means, coupled to the

first computing means, to receive the services, Wherein the second computing means is

partitioned into a plurality of private areas, each private area being dedicated to a single

client, other clients not being granted access to said private area {See Fig. 2C, Element

132}; wherein:

a third computing means is coupled to the first computing means and to the

second computing means and is an area to which the provider has access but the

clients do not have access {See Fig. 2C, Element 124}.

Conclusion

3.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

I.   <u>U.S. Patent</u>:

    1)   U.S. Patent Application Publication No. 2001/00540064 (KANNAN) is

        cited to teach a method system and computer program product for

        providing customer service over the world-wide web,

    2)   U.S. Patent No. 5,958,016 (CHANG ET AL) is cited to teach an Internet-

        web link for access to intelligent network service control, and

    3)   U.S. Patent No. 6,085,201 (TSO) is cited to teach a context-sensitive
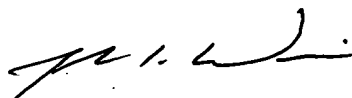
        template engine.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cang (James) G. Thai whose telephone number is (571) 272-6499. The examiner can normally be reached on 6:30 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CGT
09/4/2005

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